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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,378	02/17/2004	Jeff Blaylock	ZIM0356	1826

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EXAMINER	
PREBILIC, PAUL B	

ART UNIT	PAPER NUMBER
3774	

MAIL DATE	DELIVERY MODE
04/20/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/780,378	BLAYLOCK ET AL.	
	Examiner	Art Unit	
	Paul B. Prebilic	3774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 December 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *56-66,68,69 and 71-106* is/are pending in the application.

4a) Of the above claim(s) *69 and 71-106* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *56-66 and 68* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *12/22/09, 12/22/2009*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Election/Restrictions

Applicant's election without traverse of Group I in the reply filed on December 22, 2009 is acknowledged.

Claims 69 and 71-106 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on December 22, 2009.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 56, 58-66, and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martinez et al (US 4,994,757; designated "Martinez" hereafter) in view of Williams (US 5,824,103) in further view of Bosredon (US 6,117,175) or Murray et al (US 4,224,696; designated "Murray" hereafter).

Martinez meets the claim language where:

- the tibial augment system as claimed is met by the joint (7) of Martinez (see the abstract, Figure 1 and column 2, lines 18-65);
- the articular component as claimed is the tibial insert (11);
- the tibial plate as claimed is the base plate (15);

- the tibial post as claimed is the stem (23) and/or bolt (17) and/or stem (41) and
- the tibial augment as claimed is the plate (13).

However, Martinez fails to disclose the size range of the tibial augment (plate (13)) as now claimed. However, Williams teaches that it was known to make similar tibial implants to fit the particular patient in need, in particular, a preferred embodiment falls within the claimed ranges; see column 6, lines 45-49 where 1.44 inches equals 37 mm (1.44 inches X 25.4 mm/inch = 37 mm) and 2.44 inches equals 62 mm (2.44 inches X 25.4 mm/inch = 62 mm). Similarly, Bosredon teaches that it was known to adjust plate heights to account for patient needs (see column 7, lines 24-59), and Murray teaches that it was known to adjust plate heights based upon patient needs (see column 10, lines 61-67). Both Bosredon and Murray teach that the claimed plate height of about 15 mm was known to the art. Therefore, it is the Examiner's position that it would have been considered *prima facie* obvious to an ordinary artisan to make the plate (13) of Martinez within the claimed size range so that it could fit a large segment of the adult human population and be adapted to particular patient needs.

Regarding claims 58 and 59, the medial and lateral widths can be taken at any point so the thickness through the edge of the plate is less than at the central part of the plate to the edge inner boundary.

Regarding claim 60, the proximal end and distal end can be the left side to the right side in Figure 1.

Regarding claim 67, the Applicant is directed to column 1, lines 44-46 and the abstract.

Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martinez, Williams, Bosredon, and Murray as applied to claims 56, 58-66, and 68 above, and further in view of Johnson et al (US 6,136,029). Martinez fails to disclose the utilization of porous tantalum as the implant material. However, Johnson teaches that it was known to use porous tantalum in the art; see column 4, lines 42-58. Therefore, it is the Examiner's position that it would have been obvious to utilize porous tantalum as the implant material in Martinez for the same reasons that Johnson utilizes the same.

Response to Arguments

In traversing the rejections, the Applicant argues that the height of about 15 mm is not met. In response, the Examiner has added Bosredon and Murray et al to show that the claimed plate height has been known to the art as a way to adjust to patient needs. For this reason, the claimed invention is considered obvious over the applied prior art.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 of 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Isabella can be reached on 571-272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Prebilic/
Paul Prebilic
Primary Examiner
Art Unit 3774